

## REMARKS

This application is a continuation of copending, parent application no. 09/540,066, and is being filed to prosecute further the claims of said copending application.

Applicants wish to note that the accompanying continuation application includes a copy of the executed Declaration filed in the parent application. This Declaration, however, contains a minor informality. Specifically, the Declaration, which was filed in application no. 09/540,066 incorrectly refers to that application no. as 09/450,066. Since this Declaration was the Declaration for the parent application, it is believed appropriate to include a copy of the Declaration with the accompanying continuation application.

In the parent application, the Examiner rejected Claims 8-16 both under 35 U.S.C. §101, as directed to non-statutory subject matter, and under 35 U.S.C. §103, as being unpatentable over the prior art. In particular, Claims 8-16 were rejected as being unpatentable over U.S. Patent 6,122,560 (Tsukishima, et al.) in view of the reference “Primary production scheduling at steelmaking industries” (Lee, et al.).

In the parent application, the Examiner also objected to Claims 8-10 as being directed to a method which has no nexus with a tangible technology. Claims 17-19 were rejected under 35 U.S.C. §112 on the basis that these claims are not appropriately described in the specification. None of Claims 17-19 was rejected over the prior art, though.

This Preliminary Amendment is being filed to amend independent Claims 8, 11 and 14 to more clearly describe the differences between the claims and the prior art. Also, Claims 17-19 are being added to the application. These Claims 17-19 correspond to the Claims 17-19 that had been added to the parent application

Claims 8-16 are directed to statutory subject matter within the meaning of 35 U.S.C. §101. 35 U.S.C. §101 indicates that a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” As explained in MPEP §706.03(a), the term “process,” as defined in 35 U.S.C. §101, means “process, art or method.”

Claims 8-10 are clearly directed to a method, and in particular, to a method for allocating finished units to received customer orders. Claims 11-13 are directed to a system for allocating finished units to received customer orders. Claims 14-16 are directed to an article of manufacture, namely a program storage device embodying a program of instructions readable by a machine. These are all statutory subject matter within the meaning of 35 U.S.C. §101, as explained in MPEP §706.03(a).

In rejecting Claims 8-16 in the parent application under 35 U.S.C. §101, the Examiner argued that the claims are not concrete or tangible. Applicants respectfully disagree. The present invention, as defined by Claims 8-16, is used to allocate finished units to received customer orders. This is clearly a tangible and useful result, and the claims set forth method steps or apparatus to accomplish this result.

More specifically, the Examiner argued in the parent application that Claims 8-10 and 14-16 are not statutory subject matter because a number of different solutions could be found for a particular problem. This, though, does not make these claims non-statutory. The invention is used to identify a solution for a problem – allocating finished units to received orders – and the fact that there may be more than one solution for a particular situation does not cause the claim to be non-statutory. The purpose of the invention is not to identify every solution for a particular problem, but to identify a solution for the problem.

The Examiner also objected to Claims 8-10, and rejected these claims under 35 U.S.C. §112, on the specific grounds that the method of these claims could be accomplished by hand and claim no nexus to technological apparatus. 35 U.S.C. §101, however, does not require that method claims set forth apparatus. A statutory method claims can be defined in terms of the steps and functions needed to obtain a result without necessarily setting forth apparatus.

With respect to Claims 11-13, the Examiner specifically objected to these claims as being directed only toward accomplishing a method. These claims expressly set forth specific apparatus elements and describe the manner in which those elements cooperate together to achieve a specific result. The mere fact that the systems defined by Claims 11-13, when used, accomplish a method does not make the claims non-statutory.

Applicants respectfully submit that a review of 35 U.S.C. §101 and MPEP §706.03(a) will show that the Examiner, in previously rejecting Claims 8-16, under 35 U.S.C. §101, was construing this section to have requirements that it, in fact, does not have.

Applicants also do not agree with the previous rejection of Claims 17-19 under 35 U.S.C. §112. However, in order to eliminate this issue, Applicants have rephrased these claims, as the Examiner suggested, so that the identification of the largest area of each unit is not a part of identifying valid units.

With respect to the rejection in the prior application of Claims 8-16 under 35 U.S.C. §103, the prior art fails to disclose or suggest, among other features, the step of or means for iteratively assigning and unassigning valid, finished units to received customer orders for those units until either all the orders are fulfilled, or there are no more assignment options to be tested, in the context of independent Claims 8, 11 and 14.

Specifically, both Tsukishima, et al. and Lee, et al. address the problem of production scheduling or the scheduling of raw materials. The present invention, as defined by Claims 8, 11 and 14, does not address this issue, but instead, addresses the problem of allocating finished units to received orders. Because neither Tsukishima, et al. nor Lee, et al. address this issue, neither of these references provides any guidance or teaching that would lead one of ordinary skill in the art to develop the present invention.

Applicants are herein amending independent Claims 8, 11 and 14 to describe more clearly this difference between the claims and the prior art. In particular, these claims are being amended to indicate that the customer orders are orders for the finished units. In this way, it is clear that the “finished units” described in the claims are not the raw materials that may be used to make those finished units.

Because of the above-discussed differences between Claims 8, 11 and 14, as amended herein, and the prior art, and because of the advantages associated with those differences, these claims patentably distinguish over the prior art and are allowable. Claims 9, 10 and 17 are dependent from, and are allowable with, Claim 8; and Claims 12, 13 and 18 are dependent from Claim 11 and are allowable therewith. Likewise, Claims 15, 16 and 19 are dependent from Claim 14 and are allowable therewith.

For the reasons discussed above, it is believed that this application is in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully Submitted

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